

DAIMLERCHRYSLER

DaimlerChrysler Corporation
Corporate Patent Office

April 29, 1999

Donna L. Berry
(248) 576-5675

BY FACSIMILE: 703-305-8885

Eleanor K. Meltzer, Esq.
Attorney-Advisor
Office of Legislative and International Affairs
U.S. Patent and Trademark Office
2121 Crystal Drive, Suite 902
Arlington, Virginia 22202

Re: Official Insignia of Native American Tribes

Dear Ms. Meltzer:

We submit the following comments for your consideration in response to the Notice of Inquiry and Request for Comments pursuant to Public Law 105-330 which requires the Patent and Trademark Office to study the numerous issues pertaining to the proposed trademark protection for the "official insignia" of federally and/or State recognized Native American tribes. We are responding because we are concerned that the good intentions motivating this legislation may carry unconstitutional burdens and raise other problems, both domestically and internationally.

In a nation that recognizes and protects the flags and "other insignia" of foreign nations (15 U.S.C. 1052(b)), we believe similar rights and protection may be ascribed to Native American tribes and their official insignia as a means, in part, by which to recognize and pay tribute to their heritage and culture. However, we also believe that the parameters of those rights in and to such "official insignia" must be carefully meted out or this newly crafted provision, if enacted, could impinge broadly, and unconstitutionally, on the rights of trademark and business owners, as well as have negative international ramifications.

As the owner of numerous trademarks for motor vehicles as well as related services and associated merchandise such as CHEROKEE (also the name of a Native American tribe, now the second largest Native American tribe in the United States), Daimler-Chrysler is concerned that a broad definition of what constitutes an "insignia" could deprive it unfairly of the right to continue use of those word marks and related designs. Of course, our company is not uniquely positioned in this regard as numerous other companies have long use of marks based on the vocabulary of Native American languages, such as WINNEBAGO,

TAOS and SHASTA.¹ The influence Native American languages has played in the evolution of the American language and the vast number of words and phrases that have been adopted and used as trademarks over the years makes the proposal to accord special protection to Native American tribal insignia a problematic one. Many companies, including our own, utilize words and terms that originated with the Native American tribes. The same is true for many states and municipalities including, for example, Delaware, Illinois, Chicago and Manhattan. To take this premise to its logical extreme, prohibiting these companies from the continued use of their well-established marks and names in commerce would deprive them without due process of the valuable good will garnered by years of investment.

Accordingly, to prevent the usurpation of trademark rights which could stem from the contemplated statutory protection of the "official insignia" of Native American tribes, the definition of "official insignia" should be defined narrowly. For example, as in the case of other composite marks including heraldic crests and coats of arms, it should not include possible elements of those insignia, such as tribal names or symbols, components that may have been adopted and used by trademark owners in good faith for years.

For example, the Seal of the Cherokee Nation (reproduced below) consists of a seven-pointed star surrounded by an oak leaf wreath. The outside border of the emblem bears the words "Seal of the Cherokee Nation." Two words for "Cherokee Nation" in the Cherokee language then follow and, at the lower edge of the seal is the date "September 6, 1839." (The Cherokee Nation's web site @ www.cherokee.org provides further information on the significance of the seal's elements).



This seal may be the type of "official insignia" that would fall within the scope of protection envisioned by the proponents of the new provision. We agree that the Cherokee Nation Seal, among possible others, is entitled to protection although to do so by statute may run afoul of the various international trademark treaties to which the United States is a party. The United States is required, under treaties such as the Paris Convention,

¹ See, e.g., Registration No. 1,908,349 for WINNEBAGO for motor homes and conversion vans; Registration No. 1,713,091 for TAOS for flatware, and Registration No. 1,265,213 for SHASTA for carbonated soft drinks.

to give member states reciprocal protection. Virtually every nation's history includes tribal cultures, many of which remain alive today, such as the Aborigines of Australia and the numerous tribes of Africa including the Swahili, Zulu, Kikuyu and Masai, to name but a few. Extending the statutory protection of the Lanham Act to the "official insignia" of Native American tribes could require, as a matter of international parity, that similar protection be afforded to the "official insignia" of other tribes and their tribal descendants. When assessed from this potential perspective, the magnitude of the administrative tasks that would be necessary to implement such a program of protection becomes daunting.

If a foreign-owned company cannot continue to protect its established trademark rights in the United States because its mark is also the name of a Native American tribe, or a component of the tribe's insignia, this could well result in foreign countries refusing to protect the established trademark rights of United States companies because of native European, Asian, African or South American tribal names and symbols. This would likely result in a chaotic situation.

We also believe that any protection offered under this proposed scheme should be prospective only, as in the case of the use of Olympic symbols, emblems, trademarks and name. 36 U.S.C. § 380 provides, in pertinent part, that any person who actually used any of the protected Olympic emblems, symbols or words for any lawful purpose prior to September 21, 1950 "shall not be prohibited ... from continuing such lawful use for the same purpose and for the same goods or services." Of course, the notion that a lawful use must be "frozen in time" in order to be permissible can be problematic for a trademark owner that wishes to extend use of a well-known mark to a technologically advanced product but that may be an issue for another day. Suffice it to say at this juncture that we believe that any new protection for Native American tribe insignia should include a grandfather provision for any third party use that exists at the time of enactment.

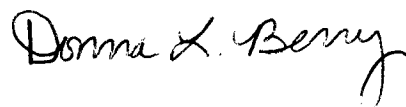
Yet another issue involving the question of time arises as to what constitutes an "official insignia" and whether any such insignia must have been used historically in order to be protected. On one hand, Native American tribes should be permitted to modernize their tribal insignia; populations evolve and the symbols they use for identification purposes change. However, any allowance for modernization should not be permitted to encroach upon the established trademark rights of others, whether by coincidence or design.

Quite clearly, the complications and potential impact on the prohibition on federal registration and "new uses" of Native American tribe insignia are significant. On the other hand, the protection afforded by the current Trademark Act may serve the same interests and meet the same goals as the provisions under consideration. For example, each tribe could register its seal or insignia as a collective mark (15 U.S.C. § 1054). Registration of confusingly similar marks could be opposed under either Section 2(a) ("false association") or 2(d) (likelihood of confusion) of the Trademark Act. Earlier this year, the Eastern Band of Cherokee Indians filed an application to register the Seal of the Eastern Band of the Cherokee Nation (see attached) for "government related services, licensing and marketing the seal for t-shirt and other merchandising sales." The cost of filing and prosecuting a trademark

application to registration is not prohibitive; utilizing an already established means by which to secure protection for official Native America tribal insignia may be the most prudent course given the complications that could arise if statutory rights are afforded to Native American tribes or groups but not others.

These comments briefly outline some of our key concerns. We would be pleased to discuss any of the above issues, or others that you believe require further comment, in greater detail. We also would welcome the opportunity to present our views before any committee you may wish to assemble to study this matter. If we can be of assistance in any of these regards, please let us know.

Respectfully yours,

A handwritten signature in black ink that reads "Donna L. Berry". The signature is written in a cursive, flowing style.

Donna L. Berry
Staff Attorney - Trademarks

Attachment

**SEAL OF THE EASTERN BAND OF THE CHEROKEE NATION NOVEMBER 28, 1870
and Design**

INTL CLASS: 35 (Advertising & Business Services)
U.S. CLASS: 101 (Advertising & Business Services)
STATUS: Misassigned Serial Number; Preliminary Drawing Page Data
GOODS/SERVICES: GOVERNMENT RELATED SERVICES, LICENSING AND
MARKETING THE SEAL FOR T-SHIRT AND OTHER MERCHANDISING SALES
SERIAL NO.: 75-429,908
FIRST USE: September 1, 1997 (Intl Class 35)
FIRST COMMERCE: September 1, 1997 (Intl Class 35)
FILED: February 6, 1998
MISASSIGNED: April 1, 1998
ORIGINAL APPLICANT: EASTERN BAND OF CHEROKEE INDIANS, PO BOX 455
- SEQUOYAH TRAIL, CHEROKEE, NC (North Carolina), 28719, USA
(United States of America)

